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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,541	03/17/2004	Lalit Kumar Wadhwa	52078/DAP/L500	3712

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EXAMINER	
SACKEY, EBENEZER O	
ART UNIT	**PAPER NUMBER**
1624	
MAIL DATE	**DELIVERY MODE**
08/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/802,541	WADHWA ET AL.	
	Examiner	Art Unit	
	EBENEZER SACKEY	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 1-12 are pending.

This is in response to applicants remarks/arguments filed on 05/21/07.

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman et al., (U.S.Patent number 5,473,078) for the reasons set forth in the previous office action mailed on 02/21/07.

Response to Remarks/Arguments

Applicant's arguments filed 05/21/07 have been fully considered but they are not persuasive. With respect to the finality of the restriction requirement, applicants alleges that the two restriction Groups should be combined and the restriction withdrawn since claim 1 and claim 12 both recite a process for preparing compounds of Formula 2. This argument is not deemed persuasive because applicants admitted in the response filed on 05/21/07 that claim 12 further recite the use of compound of Formula 2 in the preparation of compound of Formula (I) with a different solvent, a limitation which is not present in claim 1. Thus, claim 12 is considered to be of a broader scope than claim 1 and hence, is capable of supporting its own patent.

Turning to the rejection of claims 1-11 under 35 U.S.C. § 103 over Bowman et al., applicants alleges that by using a salt of 1, 2, 4-triazole of structural Formula (4) with α-halo substituted tolunitrile of Formula (3), the production of undesired side product 4-(1H-1, 3, 4-triazol-1-ylmethyl)benzonitrile is eliminated and thus results in having a 96% selectivity for the desired product of Formula (2). In response, there is no data (by way of a side by side comparison) of record to compare the instant process with that of Bowman et al. Applicants next argue that with respect to the current process, parameters such as temperature necessitate conditions, such as reactants, reagents and solvents employed in the process. Contrary to applicant's assertion, process temperature may be taken into consideration when it is considered to be a major determinant; however, such is not the case in the current process. Note that Examples in Bowman et al., recite room temperature (21^0C) as against instant process

temperature of between 25-30^{0}C. The claimed temperature is an obvious modification available to one of ordinary skill in the art as previously stated, and is considered as a mere optimization of a variable, which is not patentable absent unexpected result due to the variable, and hence is a difference in kind, and not merely in degree from that of '078'. *In re Aller,* 105 USPQ 233, (1955). Also see *In re Boesch*, 205 USPQ, 215, (1980). Moreover, applicants have not shown that the claimed temperature and salt enhances the process by providing better yield.

Thus, for the reasons of record, claims 1-11 remain rejected absent a showing of unexpected results and/or yield. Regarding unexpected results, such results must be established by factual evidence; mere argument or conclusionary statements in the specification do not suffice. Note *Geisler,* 116 F.3d at 1470, 43 USPQ 2d at 1365 (quoting *In re De Blauwe,* 736 F. 2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Furthermore, unexpected results must be established by comparing the claimed invention against the closest prior art. *De Blauwe*, *supra* ("[A]n applicant relying on comparative tests to rebut a prima facie case of obviousness must compare his claimed invention to the closest prior art").

It is suggested that applicants insert the various Formulae in claims 1, 10 and 11 for clarity.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

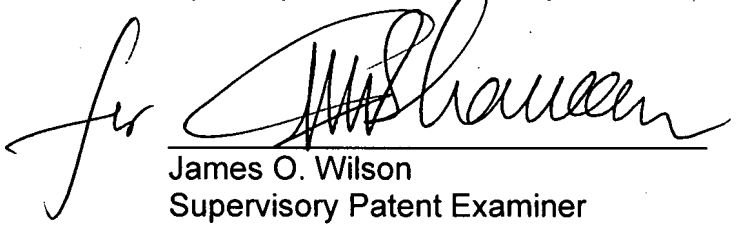
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS
August 1, 2007



James O. Wilson
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